UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,666	09/12/2005	Fritz Neubourg	2389.0010000/MAC	7322

26111 7590 10/03/2008

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER	
GREENE, IVAN A	

ART UNIT	PAPER NUMBER
4161	

MAIL DATE	DELIVERY MODE
10/03/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/538,666	NEUBOURG, FRITZ	
	Examiner	Art Unit	
	IVAN GREENE	4161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 September 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *06/10/2005, 03/08/2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of the claims

Claims 1-17 are currently pending.

Information Disclosure Statement

The information disclosure statements (IDS) submitted on 06/10/2005 and 03/08/2007 were filed before the mailing date of the first office action on the merits. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner where in English.

Priority

The US Provisional Application 60/432,632 has no English translation on file. The priority document EPO 02027828.9 has a certified copy on file, however, no English translation is on file. The effective US filing date of the instant application has been determined to be 12/12/2003 the filing date of the PCT document PCT/EP03/14153.

Rejections

Claim Rejections - 35 U.S.C. 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 7 and 17 rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

3. Regarding claims 7 and 17, the phrase "like" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

4. Instant claim 7 recites the limitation --hydrating--, and the claim also recites --(moisture binding)--. This is ambiguous and therefore lacks proper clarity, the recited substance is either "hydrating" or "moisture binding."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-17 rejected under 35 U.S.C. 102(b) as being anticipate by Neubourg (US 6,423,323 B2, hereafter referred to as '323).

This rejection is directed to the embodiment of the instant claimed invention wherein the propellant is heated during the addition to the foam cream.

Considering Claims 1, 2 and 12: '323 discloses (Abstract):

(57) **ABSTRACT**

A foam skin cream can be obtained by

preparing a phase I by melting at 75° C. a mixture containing fatty acids, especially C_{12}–C_{22} fatty acids, optionally unsaturated and/or polyunsaturated fatty acids, emulsifiers, coemulsifiers, such as triceteareth-4-phosphate, followed by metering it with stirring to

a phase II temperature-controlled at 75° C. obtained from an aqueous mixture containing moisturizers, such as propylene glycol and/or polyhydric alcohols, especially glycerol, emulsifiers, such as alkyl sarcosinates, and skin care additives, such as allantoin;

wherein homogeneous mixing of phases I and II is provided and said metering is performed at a temperature of 75° C.;

after the metered addition, the temperature is maintained at 75° C. for a period of between 5 and 20 minutes; whereupon

the temperature of the thus obtained mixture is lowered to a temperature of between 30 and 40° C. with constant stirring;

the pH value is adjusted to from 7.6 to 8.2, preferably with a skin-compatible basic organic compound, and the mixture obtained is filled into dosage forms with the addition of a propellant.

Wherein the foam skin cream comprises a phase (I) which is a lipophilic phase containing fatty acids and a phase (II) which is an aqueous mixture containing moisturizers, such as propylene glycol (hydrophilic phase). '323 further discloses the heating of the foam skin cream wherein the addition of the propellant gas is done while the mixture is at a temperature of 30 to 40˚C (i.e. heated).

Considering Claims 3-6 and 13-16: '323 discloses (col. 3, lines 36-60) the foam skin cream comprises:

> Preferably, the emulsifiers, fatty acids, coemulsifiers, moisturizers and skin care agents, especially allantoin, panthenol etc., are used in the following amounts:
>
> from 4 to 15% by weight of oil-in-water emulsifier;
>
> from 1 to 10% by weight of fatty acid, especially from 4 to 7% by weight, preferably from 4.5 to 6% by weight;
>
> from 0.4 to 2.3% by weight of coemulsifier;
>
> from 1 to 10% by weight of moisturizer;
>
> from 0.05 to 1% by weight of skin care agent; and water as the balance to make 100% by weight.
>
> A preferable foam skin cream according to the invention contains:
>
> from 1 to 3% by weight of glyceryl stearate;
>
> from 3 to 6% by weight of cetearyl alcohol;
>
> from 4 to 6% by weight of stearic acid;
>
> from 0.5 to 2% by weight of paraffin;
>
> from 0.4 to 2.3% by weight of tricetearеth-4-phosphate;
>
> from 1.5 to 4% by weight of propylene glycol;
>
> from 1.3 to 4.2% by weight of glycerol;
>
> from 1 to 3% by weight of cetyl sarcosinate;
>
> from 0.05 to 1% by weight of allantoin; and
>
> water as the balance to make 100% by weight.
>
> In another preferred embodiment, the foam skin cream according to the invention additionally contains a silicone-containing substance, such as dimethicone. This substance is added to phase I. Preferably, it is present in amounts of from 0.05 to 1% by weight.

Wherein the ingredients disclosed fully embrace those of claims 5 and 6; wherein the lipophilic component of instant claims 3, 4, 13, and 14 is fatty acids; wherein the hydrophilic component of claim 3 and 13 is propylene glycol. Examiner notes the disclosure of propylene glycol is equivalent to the claimed mono propylene glycol. Examiner further notes the disclosed glycerol is synonymous with glycerin.

Considering claims 7 and 17: '323 discloses, "It may be indicated to include substances which can increase the moisture content of the skin, in addition to refatting substances...Such hydratizing substances include, in particular, urea, ethoxydiglycol,

sodium chloride, magnesium chloride, sorbitol, dexpanthenol, sodium lactate..." (col. 4, line 48).

Considering claim 8: Claim 8 recites the method wherein the foam cream collapses or partly collapses, after the addition of the propellant gas and before conducting the heat treatment. Where the claimed invention is identical to the prior art the claimed properties are inherent in the prior art teaching. Wherein the foam skin cream disclosed in '323 is filled into containers with the addition of a propellant the foam would reasonably be expected to collapse.

Considering claims 9-11: claims 9-11 are product by process claims wherein the product is disclosed in '323, as discussed above. From the MPEP § 2113 [R-1] "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neubourg ('323) in view of Hart et al. (US Patent 3,970,584.

This rejection is directed to the embodiment of the instant claimed invention wherein the propellant is heated before the addition to the foam cream.

Determination of the scope and content of the prior art (MPEP 2141.01)

The teachings of the prior art with regards to the instant claimed invention are discussed above under, Claim Rejections - 35 USC § 102.

Ascertainment of the difference between the prior art and the claims (MPEP 2141.02)

The difference between the instant application and '323 is that '323 does not expressly teach heating the propellant gas before addition to the foam cream. This deficiency in heating of the propellant gas before its addition to the foam cream is cured by the teachings of Hart et al.

Harte et al. teaches a foam skin emulsion process with a heat treatment in aerosol containers (col. 5, lines 35-45; col. 6, lines 1 and 2). Hart et al. teaches the ingredients of part A are mixed and heated to 170°F. Hart et al. further teaches, part A is then added to part B with mild agitation and the mixture is cooled to 120°F. Hart et al. further teaches, fragrance is then added, and the mixture is further cooled to 100°F and, 142 gram samples are charged into 6 oz aerosol containers. Hart et al. further teaches, the containers are fixed with a foam-type valve and charged with 142 grams of emulsion after which the valve is crimped and the cans are filled with isobutane. Hart et al. further teaches, thereafter the cans are transferred to a "gasser-shaker" and pressurized with nitrous oxide at 100 pounds line pressure. Hart et al. further teaches, the containers are then transferred to a hot tank at 130°F for three minutes before allowing them to cool. While the reference doesn't explicitly teach the heating of the gas before its addition to the hot aerosol cans, it would be obvious to try as it would remove the final step of heating to 130°F. Furthermore there are a limited number of possibilities the gas is either heated before, during or after its addition. With only three possibilities it would be obvious to try all three.

Finding of prima facie obviousness

Rationale and Motivation (MPEP 2142-2143)

It would have been prima facie obvious that one of ordinary skill in the art at the time the claimed invention was made would have combined the foam skin cream taught by '323 with the foam-forming emulsion of Hart et al. to produce the instant claimed

invention, a stable foam cream which is heat stabilized by the addition of a gas heated before its addition. Harte et al. and '323 both teach foam skin creams. It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be useful for the very same purpose, i.e. a heat stabilized foam skin cream.

It would have been prima facie obvious to try the method of heating the gas before its injection into the foam cream because only three options exist (i.e. heating the gas after, before or during addition).

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill in the art might reasonably infer from the teachings. (*In re Opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA) 1976).

In light of the forgoing discussion, the Examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a).

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Double Patenting

Nonstatutory Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 2, 4-6, 12, 14, 15 and 16 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 10, 11, 12 and 15 of U.S. Patent No. 6,423,323 B2 (hereafter referred to as '323) in view of Hart et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claimed invention is a species of copending '323.

4. Instant claim 1 recites a method for the manufacture of a stable foam cream wherein the foam cream is substantially identical to the foam skin cream of '323, as discussed above. The method steps of the instant claimed invention differ in that the gas is heated before during or after the addition to the aerosol can.

Hart et al. teaches the heating of a foam skin cream, as discussed above.

One of ordinary skill in the art at the time the invention was made would have produced the instant claimed invention from copending '323 because the instant claimed application provides a product which could have an enhanced foam structure providing for a more stable product. Furthermore, as discussed above there are only three options for the heating of the gas, before, during or after the addition. It would have been prima facie obvious to try each of the various embodiments, especially in view of hart et. al.

Conclusion

Claims 1-17 are pending. Claims 7 and 17 are rejected under second paragraph of 35 U.S.C. 112. Claims 1-17 are rejected under 35 U.S.C. 102 as well as under 35 U.S.C. 103. No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to IVAN GREENE whose telephone number is (571)270-5868. The examiner can normally be reached on 5/4/9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

IVAN GREENE
Examiner, Art Unit 1616

/Mina Haghighatian/
Primary Examiner, Art Unit 1616